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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,895	06/27/2003	Barrett M. Kreiner	BELL-0193/02242	7209
45695	7590	08/17/2006	EXAMINER	
WITHERS & KEYS FOR BELL SOUTH P. O. BOX 71355 MARIETTA, GA 30007-1355			VU, TUAN A	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/607,895	<b>Applicant(s)</b> KREINER ET AL.	
	<b>Examiner</b> Tuan A. Vu	<b>Art Unit</b> 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 6/27/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2003/9/17</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to the application filed 6/27/2003.

Claims 1-27 (as renumbered) have been submitted for examination.

#### *Drawings*

2. The drawings are objected to because of the following: in Figure 3, boxes labeled 310 and 338 exhibit some typographical errors.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Specification: Abstract*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Specifically, the Abstract needs to be amended because the total of words therein exceeds the limit of 150 words.

#### *Claim Objections*

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4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 26 at the very end should be and has been renumbered claim 27.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a “useful, concrete, and tangible result” be accomplished. An “abstract idea” when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”.

Specifically, claim 20 recites a first system comprising software and a second system comprising software, each software for identifying, transmitting and receiving items; and a communications network coupled between first and second system for transmitting data between said systems. As claimed, the 2 systems interacting with the network amount to software operable to perform some functionality. Since, these are software entities not recited as being stored in a tangible medium or a hardware machine, it is not evident as to whether that

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functionality can be realized via execution of said software by any hardware or computing engine. The network therefore is merely coupled with 2 systems of software, whose functionality cannot be construed as being realized so to yield a result that would be otherwise tangible for use by said communications network. As a whole, the claim amounts to a non-Practical application for failing to reasonably convey that action can be executed from stored software readable by a computer, nor can data be transmitted and stored in any medium, since there is insufficient teaching, from above, that the software functionality can be actually carried out into real-world tangible data or results, thus not fulfilling the requirement that the claimed invention should produce a useful, concrete and tangible result. The claim is thus rejected for leading to a non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Salmenkaita et al., USPN: 2004/0176958 ( hereinafter Salmenkaita).

**As per claim 1**, Salmenkaita discloses method for providing remote computer access, comprising:

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receiving a first instruction, said instruction for execution on a first computer (e.g. *voice command* – Fig. 2A, 2D; receive voice command 282 – Fig. 4I; Fig 5A; user input 710-Fig 7A, input 730 – Fig. 7B; Fig. 4C-4D);

translating the first instruction into data defining at least one XML item (e.g. *voice XML tags* -para 0052; *embed voice tags in a XML message* -- para 0056-0061, pg. 4-5; para 0172-0174);

transmitting the data defining at least one XML item to a second computer (e.g. para 0085-0086, pg. 8; *Message 515, XML file 227* - Fig. 4C, D);

translating the data defining at least one XML item into a second instruction, said second instruction for execution on the second computer (e.g. boxes 216, 240, 242, 244, 246 – Fig. 4D); and

executing said second instruction on said second computer(e.g. Fig 4D; para 0177, pg. 15; Fig. 4E).

**As per claims 2-3**, Salmenkaita discloses said first instruction comprises receiving an instruction for outputting data or displaying data (e.g. display area 102B --Fig. 1; *recommended services* – Fig 2B-C; Figs. 3; *prepared updated MENU 224* – to device 100: *MENU message 509* – Fig. 4B, 4D – Note: selection by wireless user for a recommendation being serviced and updated by server for retransmission back to wireless client as updated recommendation MENU reads on instruction of data outputting).

**As per claim 4**, Salmenkaita discloses receiving an instruction for outputting data comprises receiving an instruction for generating a sound (e.g. *audio metadata 125'* – Fig. 4B; *audio output* - para 0085, pg. 8).

**As per claims 5 and 7**, Salmenkaita discloses receiving said first instruction comprises receiving an instruction for inputting data; an instruction indicating a computer keyboard input ( Fig. 1).

**As per claim 6**, Salmenkaita discloses input via a touch pad, the use of touchpad in some small device to provide mouse functionality was equivalent to a mouse click (touch pad as in *Touch sensor* - para 0072, pg. 6; Fig. 1).

**As per claim 8**, Salmenkaita discloses generating a first XML tag defining the beginning of an XML item, generating a data item corresponding to the first instruction, generating a second XML tag defining the end of an XML item (e.g. Table D, E, pg. 14; para 0155, pg. 11; *processing instruction* – para 0163-0164, pg. 12).

**As per claim 9**, Salmenkaita discloses transmitting the data using HTTP (e.g. Fig. 6, para 0179, pg. 15; para 0266-0271, pg. 22; Fig. 3D).

**As per claim 10**, Salmenkaita discloses translating the data into a second instruction comprises identifying a first XML tag defining the beginning of an XML item, identifying a data item corresponding to an instruction, identifying a second XML tag defining the end of an XML item ( para 0232, pg. 19; *specification ... activity* – para 0156, pg. 11; para 0163-0164, pg. 12).

**As per claim 11**, Salmenkaita discloses translating comprising determining the second instruction corresponding to the data item (para 0155, pg. 11; *processing instruction* – para 0163-0164, pg. 12; para 0232, pg. 19).

**As per claim 12**, Salmenkaita discloses a computer readable medium (refer to claim 1 for corresponding rejection) having computer-implementable instructions stored thereon for performing the method recited in claim 1.

**As per claim 13**, Salmenkaita discloses a method for providing remote computer access, comprising:

receiving instructions relating to generating output (e.g. *voice command* – Fig. 2A, 2D; receive voice command 282 – Fig. 4I; Fig 5A; USER INPUT 710-Fig 7A, input 730 – Fig. 7B; Fig. 4C-4D – Note: input by user by voice or keypad to trigger retransmission of updated presentation of recommendations --from server-- and for redisplay thereof **reads on** instructions relating to generating output -- see *prepared updated MENU 224* – to device 100: *MENU message 509* – Fig. 4B, 4D);

translating the instructions relating to generating output into data defining at least one XML item (*voice XML tags* -para 0052; *embed voice tags in a XML message* -- para 0056-0061, pg. 4-5; para 0172-0174);

transmitting the data defining at least one XML item; receiving data defining an XML item relating to inputs (e.g. para 0085-0086, pg. 8; *Message 515, XML file 227* - Fig. 4C, D – Note: transmitting by wireless device -- Fig. 4C, 4E -- **reads on** receiving by the server -- Fig. 4D, 4F);

translating the data defining an XML item relating to inputs into instructions relating to inputs (e.g. boxes 216, 240, 242, 244, 246 – Fig. 4D; Fig. 4F and related txt); and

executing the instructions relating to inputs (Fig 4D; para 0177, pg. 15; Fig. 4E and related text).

**As per claim 14**, Salmenkaita discloses receiving instructions relating to generating output comprises receiving instructions relating to generating visual or audio output (*audio metadata 125* – Fig. 4B; *audio output* - para 0085, pg. 8; display area 102B --Fig. 1).



**As per claims 15-17**, these claims correspond to claims 8-10 respectively; therefore will incorporate the corresponding rejection as set forth therein.

**As per claim 18**, Salmenkaita discloses a method for providing remote computer access, comprising:

receiving instructions relating to user inputs; translating the instructions relating to user inputs into data defining at least one XML item; transmitting the data defining at least one XML item; receiving data defining an XML item relating to outputs; translating the data defining an XML item relating to outputs into instructions relating to outputs; and executing the instructions relating to outputs;

these step limitations having been addressed in claim 13 from above.

**As per claim 19**, Salmenkaita discloses using the HTTP protocol to transmit the data defining at least one XML item (e.g. Fig. 4; Fig. 6, para 0179, pg. 15; para 0266-0271, pg. 22; Fig. 3D).

**As per claim 20**, Salmenkaita discloses a system for remote computer access, comprising:

a first computing system (e.g. Fig. 4C, 4E ) comprising software for identifying instructions relating to generating system outputs, transmitting data defining an XML item corresponding to the instructions relating to generating system outputs, and receiving XML items corresponding to user inputs (all of which limitations being addressed in claim 13);

a second computing system (e.g. Fig. 4D, 4F) comprising software for identifying instructions relating to user inputs; transmitting data defining XML items corresponding to the

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instructions relating to user inputs, and receiving XML items corresponding to generating outputs ( all of which limitations being addressed in claim 13) ; and

a communications network operably coupled between said first computing system and said second computing system for transmitting data between said first computing systems and said second computing system ( refer to claim 1).

**As per claim 21**, Salmenkaita discloses a method for providing remote computer access, comprising:

receiving instructions relating to generating output;

creating data defining at least one XML item corresponding to the instructions relating to generating output;

transmitting the data defining at least one XML item;

receiving data defining an XML item relating to inputs ( Note: server receiving XML messages reads on receiving item relating to inputs);

creating instructions relating to inputs from the data defining an XML item relating to inputs; and

executing the instructions relating to inputs;

all of which limitations having been addressed in claim 13.

**As per claims 22-25**, these claims correspond to claims 14-17, respectively; therefore will incorporate the corresponding rejection as set forth therein.

**As per claim 26**, Salmenkaita discloses a method for providing remote computer access, comprising:

receiving instructions relating to user inputs;

creating data defining at least one XML item corresponding to the instructions relating to user inputs;

transmitting the data defining at least one XML item;

receiving data defining an XML item relating to outputs;

creating instructions relating to outputs corresponding to the data defining an XML item relating to outputs; and

executing the instructions relating to outputs;

all of which step limitations having been addressed in claim 13.

**As per claim 27**, see Salmenkaita (e.g. Browser 102, Fig. 3B; Fig. 6, para 0179, pg. 15; para 0266-0271, pg. 22; Fig. 3D)

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 ( for non-official correspondence - please consult Examiner before using) or 571-273-8300 ( for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Tuan A Vu', with a long horizontal line extending to the right.

Tuan A Vu  
Patent Examiner,  
Art Unit 2193  
August 16, 2006